

PATENT
RESPONSE AFTER FINAL
EXPEDITED PROCEDURE
UNDER 37 C.F.R. § 1.116

the above-identified application. Applicant respectfully requests entry of the following amendment and consideration of the following comments.

Please amend the application as follows:

IN THE CLAIMS:

Claim 17, line 1, delete "A" and substitute therefore --An adhesive--.

REMARKS

Claims 1 and 17-39 are pending in this application. In the Office Action mailed March 8, 2000, Claim 1 is not listed among the pending claims. Applicant's representative was unsuccessful in several attempts to reach the Examiner and Acting Supervisory Patent Examiner Moezie by telephone in order to resolve the status of Claim 1. Examination of Claim 1 is respectfully requested.

Claims 17-25 have been rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by Japanese Patent Publication No JP 07179606 to Norihiro et al. ("Norihiro et al.") in view of Chemical Abstracts CA 123:278677 to Mariconi et al. ("Mariconi et al."). The Examiner has alleged that Norihiro et al. teach an adhesive composition comprising 5-amino-1-(2,6 dichloro-4-trifluoromethylphenyl)-3-cyano-4-

**PATENT
RESPONSE AFTER FINAL
EXPEDITED PROCEDURE
UNDER 37 C.F.R. § 1.116**

trifluoromethane sulfoninyl pyrazol (fipronil) and a vinyl acetate-ethylene thermosetting copolymer, and that Mariconi et al. teach the termiticidal activity of fipronil. Therefore, the Examiner has alleged, it would have been obvious to formulate an inherently adhesive composition comprising fipronil and vinylacetate-ethylene copolymer.

Claims 17-25 are directed to a composition consisting essentially of a wood adhesive and an insecticidally active material of Formula I, which formula includes fipronil. The compositions of the present invention are useful for bonding wood or wood particles.

Norihiro et al. do not teach or suggest the compositions of the present invention. For the Examiner's convenience, an English translation of the Japanese patent application corresponding to the cited Norihiro et al. abstract is enclosed. As evidenced by the abstract and published application, Norihiro et al. disclose an insecticide-coated granule that is sprayed on plants. The granules are made by coating a granular carrier (limestone, calcium carbonate, silica sand, silica rock, or glass beads) with a thermoplastic resin, and then stirring the carrier with an active ingredient, e.g. an insecticide, to coat the carrier with the active ingredient. It is clear from the disclosure of Norihiro et al. that the thermoplastic resin is used "as an adhesive" only to coat the active

PATENT
RESPONSE AFTER FINAL
EXPEDITED PROCEDURE
UNDER 37 C.F.R. § 1.116

ingredient onto the granule, and that the resulting granules are not inherently adhesive compositions. Norihiro et al. do not teach or suggest that the granules are adhesive compositions. Rather, the granules are used to deliver insecticide by spraying in agricultural and horticultural applications. ✓

The Examiner has alleged that the designation “wood adhesive” in the preamble of the claims is an intended usage only. Applicant respectfully disagrees. First, Applicant points out that Claims 17-25 recite wood adhesive in the body of the claim, and thus wood adhesive is clearly a component of the claimed compositions. Further, entry of the present amendment of Claim 17 to include “adhesive” in the preamble is requested. Applicant submits that this amendment further clarifies the claimed subject matter. The compositions of Norihiro et al. are made utilizing a thermoplastic resin, but the resulting compositions are not adhesive. In the present invention the compositions per se are adhesive, and hence the language in the preamble imparts structure and function, and not merely intended usage.

Further, Claims 17-25 recite “consisting essentially of” a wood adhesive and a material of formula 1, and thus exclude the granular carriers of Norihiro et al. Neither Norihiro et al. nor Marconi et al. alone or in combination teach or suggest

**PATENT
RESPONSE AFTER FINAL
EXPEDITED PROCEDURE
UNDER 37 C.F.R. § 1.116**

compositions consisting essentially of adhesive and active ingredient, and thus cannot render the present invention obvious. Withdrawal of the rejection of Claims 17-25 under 35 U.S.C. § 103 (a) is respectfully requested.

Claim 26 has been rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by Norihiro et al. in view of Mariconi et al. and further in view of Chemical Abstracts CA 76:73225 to Schultz et al. ("Schultz et al."). Schultz et al. is cited as allegedly disclosing pheno-formaldehyde as a thermosetting resin. Claims 26 and 27 have been rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by Norihiro et al. in view of Mariconi et al. and further in view of Chemical Abstracts CA 94:9756 to Graser et al. ("Graser et al.") in view of Japanese patent abstract JP 790060078 to Yoshitomi Pharm ("Yoshitomi Pharm.") which allegedly teach formaldehyde-phenol-resorcinol, phenol-formaldehyde, and resorcinol-formaldehyde as wood adhesives. The Examiner has alleged that it would have been obvious to select among equally suitable thermosetting resins for use in combination with an insecticide. As discussed hereinabove, Norihiro et al. and Mariconi et al. fail to teach or suggest adhesive compositions consisting essentially of a wood adhesive and active ingredient. Thus there would be no motivation to combine the resins of Schultz et al., Graser et al. or Yoshitomi

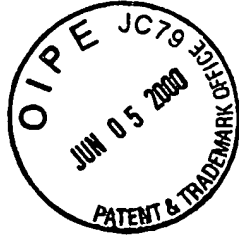
**PATENT
RESPONSE AFTER FINAL
EXPEDITED PROCEDURE
UNDER 37 C.F.R. § 1.116**

Pharm. with the primary reference, nor would the combination thereof achieve the present invention. Withdrawal of the rejection of Claims 26 and 27 under 35 U.S.C. § 103(a) is respectfully requested.

Claims 30-39 have been rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by U.S. Patent No. 5,747,519 to Kodama et al. ("Kodama et al.") and the abstract of Japanese Patent Application No.. JP 10122148 to Sumitomo Chem. ("Sumitomo Chem."). The Examiner has alleged that Kodama et al. teach a method of controlling pests by treating wood with fipronil in a thickening or bonding agent, and that Sumitomo Chem. teaches plywood plates bound with an insecticidal adhesive. The Examiner has alleged that it would have been obvious to use fipronil as an alternative to the insecticides of Sumitomo Chem., with resins known to be wood adhesives, to bind layers of wood.

Kodama et al. teach an insecticidal composition for treating wood or wood products. Kodama et al. do not teach or suggest a composition containing an insecticide and an adhesive for bonding wood particles or layers to make a wood-based material.

Sumitomo Chem. teaches a preparation comprising O,O-dimethyl O-(3-methyl-4-nitrophenyl) phosphorothioate (metathion), an adhesive such as urea melamine,



FILE NO. A32002-PCT-USA-072667.0111

**PATENT
RESPONSE AFTER FINAL
EXPEDITED PROCEDURE
UNDER 37 C.F.R. § 1.116**

and a non-ionic and/or anionic surface active agent. There is no teaching or motivation to substitute fipronil for metathion, which are not equally suitable insecticides.

Accordingly, there is no motivation to combine the teachings of the cited references, nor would the combination thereof achieve the presently claimed invention. Withdrawal of the rejection of Claims 30-39 under 35 U.S.C. § 103(a) is respectfully requested.

In view if the foregoing comments and amendments, reconsideration and allowance of Claims 1 and 17-39 is respectfully requested.

Respectfully submitted,


Louis S. Sorell
Patent Office Reg. No. 32,439

Janet M. MacLeod
Patent Office Reg. No. 35,263

Attorney for Applicant
(212) 408-2597